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EXAMINER

ZIMMERMAN, BRIAN A

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 32

Application Number: 08/998,302
Filing Date: December 24, 1997
Appellant(s): STANFIELD ET AL.

Terry Callaghan
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 8/16/02.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct, except for the fact that the rejections of claims 53-63 have been withdrawn. Claims 53-63 are allowed.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct, except for the fact that the rejections of claims 53-63 have been withdrawn.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4376936	- Kott	3/15/83
5455409	- Smith	10/3/95
4636950	Caswell	1/13/87
5063380	- Wakura	11/5/91
5287414	- Foster	11/15/94
3701987	- Leighton	10/31/72
5389919	- Warren	2/14/95
5426284	- Doyle	6/20/95
Dallas Semiconductor	Touch the Future: Automatic Identification	1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-6, 11-14, 16, 18, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and Kott (4376936).

Smith shows a file tracking system in which a processor is connected to a bus that is connected to a folder retainer 12. The processor gets requests from an input device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that an indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a database for maintaining location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses polling to determine the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder that is placed in a file retainer and is polled by a processor in the retainer via a shared conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. The folder responds to a polling signal to indicate its location. It is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents' information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

The references above show the use of LEDs as indicators to assist in locating the file. The examiner takes official notice that activating an LED with a transistor, in the manner claimed, is common practice for driving LEDs.

2. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Kott as applied to claim 1 above, and further in view of Foster (5287414).

In an analogous art, Foster shows a file locating system that includes a PC 24 to record and display the location of the files. This provides assistance to the user in determining the location of a desired file. When the drawer is closed the codes are again input into the computer to update the location database. Col. 4 lines 19-26. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a PC for storing and displaying the location of a desired file, since such would assist the user in determining the location of a desired file.

3. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott and Foster as applied to claims 1 and 7 above, and further in view of Doyle (5426284).

In an analogous art, Doyle shows a file locating system that includes a computer (figure 2). The computer includes links 216 and 220 for communicating to other computers. The examiner takes official notice that the use of a LAN to connect computers is very common in the art of computer networks, and as such would have been verily obvious to one of ordinary skill at the time of the invention.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott as applied to claims 1 and 12 above, and further in view of the Dallas Semiconductor publication "Touch the Future."

The article shows the use of trays for holding objects that are to be located. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a tray for holding and communicating with files in the manner suggested by the above modified system since such would provide increased locating abilities.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott as applied to claims 1 and 12 above, and further in view of Leighton (3701987).

Leighton shows the positioning of the communication rails on the bottom of the file drawer. See figure 4. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized communication rails on the bottom of the drawer of the above modified system to provide an equivalent communication to the files.

6. Claims 19-45, 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and Kott (4376936) and Wakura (5063380).

Smith shows a file tracking system in which a processor is connected to a bus that is connected to a folder retainer 12. The processor gets requests from an input

device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that a indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a database to maintain the location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses a polling request to query the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder that is placed in a file retainer and communicates with the retainer via a common conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. The folder responds to a polling signal to indicate its location. It is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

In an analogous art, Wakura shows a file locating system that includes a central computer that sends request to locate files to cabinets 10 (figure 4). Each cabinet is in

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communication with the files it is currently storing, and has a display on the computer and the cabinet to assist the user in finding the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the distributed scheme suggested by Wakura in the above modified system in order to assist the user in finding the located file.

7. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott, and Wakura as applied to claim 43 above, and further in view of Warren (5398919).

In an analogous art, Warren teaches the use of a permission list to authorize the user to access the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a permission list to authorize the user to use the above modified system since such would increase security.

(11) Response to Argument

The appellants argue that Kott cannot send a reply signal back to the control circuit. The appellant further argues that Kott does not maintain a database including identification codes of files. The reference to Kott is not cited for teaching either of these features. Smith is cited for teaching a reply signal back to the control circuit and Smith is also cited for showing that maintaining a central database is common in the art.

The appellants argue that neither Kott nor Smith suggest the desirability of the modification that would be necessary to provide a system resembling the claimed invention. First, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found **either** in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Smith expresses their desire of having fewer dedicated wires and reducing expense, col. 3 lines 10-15. This is the exact motivation offered by the examiner as motivation to combine Kott and Smith, since Kott provides communication to each folder without requiring dedicated wires or cable to each folder.

The appellants argue that Smith cannot operate with file folders. The appellant does admit that Smith is related to the organization of article such as books, tapes, cassettes and the like, but is adamant that Smith cannot be used in a file folder system. It is well held that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, Smith is directly concerned with organizing and

locating the articles, which is exactly the same concern (or problem solved) as Kott and the presently claimed invention.

The appellants argue that Smith does not suggest the need to transmit a unique address of particular article to the article itself, since Smith uses a dedicated line. In view of the teachings of Kott, dedicated lines are expensive and would be replaced with a common bus. Also in view of Kott, sending a unique address to particular article is part of the method used in locating the article when a common communication bus is used. Note that Smith uses a common bus to communicate to the different power data modules and communicates to these using polling messages that are commonly uniquely addressed messages, see abstract and figure 1.

The appellants argue that Smith does not transmit a reply signal back to the controller including the unique serial number of the article. Smith does shows a polling scheme to acquire information regarding the location of the article, again see abstract where Smith states that a polling system is used to identify the location of the article. Col. 17 of Smith explains some of the communication exchanges where:

“...return signals fed to the computer 52 on line 150c provide the location and identification of an individual tape cartridge carrier in which a requested tape cartridge is stored.”

The appellants argue that Kott does not teach an addressable file folder responsive to a control signal including a unique address to transmit a signal back to the

processor. This statement, while true is misleading. It is true that a reply signal is not returned to the processor, however this Kott is not cited for teaching this feature. However, it is equally true that Kott does teach an addressable file folder that is responsive to a control signal including a unique address.

The appellants argue that Kott's indicator does not transmit any signals back to the processor. The appellant is correct, however it is not clear how this pertains to the claimed subject matter. The claims do not exclude the use of an indicator, and the argument ignores the teachings of Smith that are applied in the instant application.

The appellants argue that using the teachings of Kott in Smith's system would destroy the ability of Smith to determine the location of an article. First, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the teachings of Kott would aid Smith's objects by reducing the number of wires between the power data module and the articles, and would in no way destroy the ability of Smith to determine the location of an article.

The appellants argue that the only way Kott's teachings could be applied to Smith's system were if the microcontroller were reprogrammed. This statement is illustrative of the position that the appellant is arguing: "the references cannot be physically combined" this is contrary to the intent of an obviousness rejection, see case law cited above.

The appellants argue that Smith fails to show accessing a memory device to determine the location of the article. Smith does teach that it is common to maintain location information in a central database, which associates the article's unique ID with its current location, but admits that some problems occur in maintaining the freshness of such a database. See col. 4 lines 6+. Additionally, Smith states that it is common to search for the tape code to access the location where the article is stored. Col. 4 lines 1+. The use of a central database with Smith's locating system would provide quickly searchable information to determine the location of the article and would be a welcome feature to add to the Smith system.

The appellants argue that Wakura does not provide the specific structure of claim 28. This broad sweeping statement does not point to any particular reasoning what is missing from the references forming the combination rejection. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The appellants argue that they are not clear why an artisan would modify Smith to include a display since Smith is designed for use with a Robotic Arm. The appellant points to **no facts** that support their conclusion that Smith can only be used with a robotic arm, in fact the appellant doesn't even point to a location in Smith where Robotic Arm is mentioned. Furthermore, Smith specifically shows a display 66 that is used to indicate the location of the desired article. Col. 10 lines 44-49.

The appellants argue that they strongly disagree with the Examiner's statement that Smith suggests sending a signal directly to the article that inherently uniquely identifies the article and the cabinet where the article is located. The Examiner maintains that this is inherent in Smith because, as described in col. 10 of Smith, the power modules 64 poll the articles 12 to find the location of the article and upon determining the location of the requested article, a message is sent to the display. Note that the signals of Smith may be on different lines, but those lines do provide signaling directly to the article that uniquely identifies the article and the location of the article. Furthermore, it is pointed out that Kott and Wakura teach a uniquely addressed signal to the article to perform location features.

The appellant's arguments regarding claims 30-33 appear to be the same as the arguments presented on pages 41 and 42 of their Appeal Brief and have been addressed above.

The appellants argue (regarding claims 34,36 and 42) that the references do not teach a folder that is configured to couple the addressable device, on each folder, to the bus when the article is positioned in each of several different positions. The appellant fails to even address the interpretation of Kott. As stated previously, Kott's folders provide a means to couple the addressable device to the bus when the folder is in each of several positions. For example: When the folder is in the front position the drawer coupling is provided, as well as when the folder is in a position in the back of the drawer coupling is also provided.

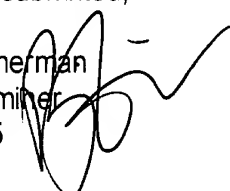
The appellant's arguments regarding claim 38 (and the claims depending on 38), the appellant points out that in some respects claim 38 is broader than claim 1 in that claim 38 does not require a bus or database. However the appellant argues that the references do not teach a conductor coupled to the folder contacts at a plurality of locations on the file folder. The three contacts on the bus provide a plurality of locations for the conductor (communication bus) to contact the folder. The appellant is attempting to read limitations into the claim that do not exist by stating that figures 5 and 6 define the claims.

The appellant's arguments regarding claim 43 (and the claims depending on 43). The appellant argues that the references do not teach a database for storing general file information including a description **at least one** of a description of contents, classification, a keyword list....etc. As discussed above, Smith (and Wakura) teaches the use of databases for storing the location of a article and a manner in which the article is identified (a unique number). This identification is considered a classification of the article.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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